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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,296	04/28/2006	Eitora Yamamura	07200076001	9736
22511	7590	11/01/2007	EXAMINER	
OSHA LIANG L.L.P. 1221 MCKINNEY STREET SUITE 2800 HOUSTON, TX 77010			MEAH, MOHAMMAD Y	
			ART UNIT	PAPER NUMBER
			1652	
			NOTIFICATION DATE	DELIVERY MODE
			11/01/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@oshaliang.com  
buta@oshaliang.com

## Office Action Summary

Application No.

10/577,296

Applicant(s)

YAMAMURA ET AL.

Examiner

Mohammad Meah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-38 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37.CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All · b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

### **DETAILED ACTION**

The claims 1-38 are pending in the instant office action.

#### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claims 1, 2, 5, 8, 9, 27-28, DNA fragment comprising SEQ ID NO: 35, plasmid, vector and transformant containing said DNA fragment.

Group 2, claims 1, 2, 5, 8, 9, 27-28 DNA fragment comprising SEQ ID NO: 36, plasmid, vector and transformant containing said DNA fragment.

Group 3, claims 1, 2, 5, 8, 9, 27-28 DNA fragment comprising SEQ ID NO: 37, plasmid, vector and transformant containing said DNA fragment.

Group 4, claims 3-4, 5, 8, plasmid or DNA fragment comprising SEQ ID NO: 1,

Group 5, claims 3-4, 5, 8, plasmid or DNA fragment comprising SEQ ID NO: 4,

Group 6, claims 3-4, 5, 8, plasmid or DNA fragment comprising SEQ ID NO: 14,

Group 7, claims 3-4, 5, 8, plasmid or DNA fragment comprising SEQ ID NO: 17,

Group 8, claims 3-4, 5, 8, plasmid or DNA fragment comprising SEQ ID NO: 22,

Group 9, claims 6-7, 8, 9, DNA fragment comprising SEQ ID NO: 76, plasmid, vector and transformant containing said DNA fragment.

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Group 10, claim 10, plasmid comprising SEQ ID NO: 73.

Groups 11-13, claims 12-13,24, 27-28, DNA fragment comprising SEQ ID NO: 70 or 71 or 72, plasmid, vector and transformant containing said DNA fragment, wherein group 11 refer to SEQ ID NO: 70 and so on.

Groups 14-24, claims 14-17,24 plasmid or DNA fragment comprising SEQ ID NO: 42, 44,---69, wherein group 14 comprise SEQ IDNO: 42 and so on.

Group 25, claims 18-19, 24, plasmid or DNA fragment comprising SEQ ID NO: 67.

Group 26, claims 18-19, 24, plasmid or DNA fragment comprising SEQ ID NO: 47.

Group 27, claims 20-22, plasmid or DNA fragment comprising SEQ ID NO: 75, plasmid, vector and transformant containing said DNA fragment.

Group 28, claims 23, plasmid comprising SEQ ID NO: 74.

Group 29, claims 25-26, 29-34, DNA fragment comprising SEQ ID NO: 77, plasmid, vector and transformant containing said DNA fragment.

Group 30, claims 30-34, DNA fragment comprising SEQ ID NO: 79, plasmid, vector and transformant containing said DNA fragment.

Group 31, claim 35-38, method production of amino ethanol using transformant containing polynucleotide t comprising SEQ ID NO: 79

The inventions listed in Groups 1-31 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature of Group 31 is the method steps using particular reagents. Said steps include making a product using transformant of groups 29 or 30. However said product can be made with other method using different technical feature such as using chemical reagent. Groups 1-30 do not share same technical feature because they involve DNA of different structure.

Furthermore, the technical feature linking group 1-31 appears to be that they all relate to plasmid originated from a microorganism genus *Rhodococcus* which does not constitute a "special technical feature" as defined by PCT Rule 13.2, because it does not claim a feature which defines a contribution over the prior art as plasmid originated from genus *Rhodococcus* are taught thorough *Appld Microbiol Biotechnol.* (2003, vol. 62, pp 61-68, from IDS)

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request

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under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad Meah whose telephone number is 571-272-1261. The examiner can normally be reached on 8:30-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

A handwritten signature in black ink, appearing to read 'Mohammad Meah', with a stylized, cursive script.

Mohammad Younus Meah, PhD

Examiner, Art Unit 1652

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